

REMARKS

Claims 1-72 remain pending. Reconsideration is respectfully requested in light of the following remarks.

Section 121 Restriction:

The Examiner presented a new restriction requirement requiring election of one of the following two inventions as defined by the Examiner:

A. Claims 1-47 and 67-72 are drawn to a method and medium for configuring a plurality of software components of an intelligent device, classified in class 709, subclass 220.

B. Claims 48-72 are drawn to the intelligent device itself, classified in class 709, subclass 201.

Based on the definitions of Invention A and Invention B as provided by the Examiner, Applicant assumes that the Examiner intended to list claims 1-47 and **66-72** as associated with Invention A, and claims 48-**65** as associated with Invention B.

Applicant elects Invention A (claims 1-47 and 66-72), as defined by the Examiner, **with traverse**. Applicant traverses the restriction requirement for at least the following reasons.

The Examiner asserts that restriction is proper under MPEP 806.05(j) because “Inventions A and B are directed to related processes.” However, the claims groups for Inventions A and B do not recited related processes. In fact, **as defined by the Examiner himself**, Invention B is for the intelligent device itself, not a process. Thus, Invention A and B clearly cannot be restricted as related processes since Invention B is not even a process. Nor is Invention A limited solely to a process (note that claims 66-72 are drawn to a storage medium, not a process). Therefore, the restriction requirement on the basis of related processes is clearly improper.

Furthermore, a proper restriction requirement under M.P.E.P. 806.05(j) requires the Examiner to show “two-way distinctness.” The Examiner has not even attempted to show how the requirements for two-way distinctness are met. More specifically, M.P.E.P. 806.05(j) requires the Examiner to show:

- (A) the inventions *as claimed* do not overlap in scope, i.e., are mutually exclusive;
- (B) the inventions *as claimed* are not obvious variants; and
- (C) the inventions *as claimed* are either not capable of use together or can have a materially different design, mode of operation, function, or effect.

The Examiner has not shown how all three of these requirements are met. For example, there is clearly overlap in scope between the claims of invention A and the claims of invention B. Applicants are by no means asserting that the scope of the claims of invention A is identical to the scope of the claims of invention B. In fact there are clearly differences in scope between the claims. However, claims of invention A do have some overlap in scope with claims of invention B. From even the most cursory glance, it is readily apparent that the functionality of the program instructions executable in the device of claim 48 is similar to and overlaps in scope with the actions of the method recited in claim 1. For example, claim 1 and claim 48 both recite a plurality of configuration files on the intelligent device, wherein each of the configuration files includes configuration information for one of a plurality of software components of the intelligent device. Moreover, claim 1 and claim 48 both recite generating a batch configuration document. Note that M.P.E.P. 806.05(j) requires that the inventions as claimed must be mutually exclusive. As shown above, claim 1 and claim 48 are not mutually exclusive. A product could be constructed that would infringe both claims. Thus, claim 2 and claim 48 are not mutually exclusive. Therefore, since the claims of invention A have some overlap in scope with claims of invention B (i.e., the claims are not mutually exclusive), restriction cannot be required under M.P.E.P. 806.05(j). Accordingly, the Examiner’s restriction requirement is improper.

Moreover, according to M.P.E.P. 806.05(j): “The burden is on the examiner to provide an example to support the determination that the inventions are distinct.” **The**

Examiner has provided no such example that would illustrate how all three of the above-listed requirements for two-way distinctness have been met. Thus, the Examiner has failed to state a *prima facie* restriction requirement.

Another shortcoming of the Examiner's restriction requirement is in regard to the requirement of M.P.E.P. § 808 for the Examiner to also show "reasons why there would be a serious burden on the examiner if restriction is not required". In regard to this requirement, the Examiner states that the inventions would require a different field of search. However, to state a proper restriction requirement, the Examiner must explain what the field of search is for each invention and why the field of search is different for each invention. Moreover, as required in M.P.E.P. § 808.02, the Examiner must show that each different field of search is in fact pertinent to the type of subject matter covered by the respective claims. The Examiner has provided no such explanation. Therefore, the Examiner has failed to state a proper restriction requirement.

Applicants note that the different classifications indicated for the inventions do not justify different fields of search because the purported classifications are inaccurate and clearly not separate for the two claim groups. For example, the Examiner states that Invention A is classified as class 709, subclass 220, and that Invention B is classified as class 709, subclass 201. However, these classifications could both be applied to all of the claims, and are thus not separate for the two groups. According to the Manual of Classification, the definition of class 709, subclass 220 is for network computer configuring. The definition for class 709, subclass 201 is distributed data processing. However, both Invention A and Invention B pertain to batch configuration of components on a device. Network computer configuring (subclass 220) or distributed data processing (subclass 201) is neither required nor excluded for either Invention A or B. Thus, the Examiner's classifications are neither accurate nor separate for Invention A and Invention B. Since the purported classifications are not very accurate and could actually relate to all of the claims, the Examiner clearly cannot rely upon these flawed classifications to justify different fields of search and "a serious burden on the examiner if restriction is not required." *See* M.P.E.P. § 808. Since the Examiner's has failed to establish a "serious

burden on the examiner if restriction is not required”, Applicants’ assert that the Examiner has not established all of the necessary elements of a *prima facie* restriction requirement as required by M.P.E.P. § 808. Therefore, the Examiner’s restriction requirement must be withdrawn.

In summary, the Examiner’s restriction requirement is flawed for at least the following reasons: i) the Examiner has incorrectly characterized Inventions A and B as being directed to related processes; ii) the Examiner has not met his burden to show by way of example how all three of requirements for two-way distinctness are met; and iii) the Examiner has failed to establish any valid “reasons why there would be a serious burden on the examiner if restriction is not required.” Thus, a *prima facie* requirement for restriction has not been stated. Accordingly, withdrawal of the requirement for restriction is respectfully requested.

CONCLUSION

Applicant submits the application is in condition for allowance, and prompt notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5181-78701/RCK.

Respectfully submitted,

/Robert C. Kowert/
Robert C. Kowert, Reg. #39,255
Attorney for Applicant

Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C.
P.O. Box 398
Austin, TX 78767-0398
Phone: (512) 853-8850

Date: February 15, 2007